

REMARKS

I. To facilitate prosecution, claims 4, 9-16, 23-26 and 42 were canceled without prejudice to divisional prosecution as being directed to a non-elected invention; and claims 5-6, 17-22 and 34-37 were cancelled without prejudice to continuing prosecution.

Some of the amendments to the claims are solely to provide clarity. Macular degeneration is taught at page 3, line 3; and the various sites of neovascularization are taught at page 1, lines 10-13.

II. In items 2-4 on page 2 of the Office Action, the Examiner summarized the Election of Species and Restriction Requirement.

Applicant herein affirm the Election without traverse of the invention of Group No. II, claims 1-3, 5-8, 17-22 and 27-41.

Claims 4, 9-16, and 23-26 were cancelled without prejudice to prosecution in a division application.

III. In item 5 at the bottom of page 2 of the Office Action, claims 1-5, 20 and 29 were objected to because the claims are not directed to the elected invention.

The amended claims have been crafted in light of the elected invention and thus, the objection can be removed.

IV. In items 7 and 8 on page 3 of the Office Action, claims 1-5, 20 and 29 were rejected under 35 U.S.C. §112, second paragraph, for allegedly omitting essential steps.

The rejection is traversed for the following reasons.

While not acquiescing to the position of the Examiner, Applicants have adopted the language proposed by the Examiner to overcome the rejection. Hence, the rejection can be removed.

V. In items 10 and 11 on pages 3-5 of the Office Action, claims 1, 3, 5-8, 17-22 and 28-41 were rejected under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the written description requirement. The issue relates to claims that teach fragments, derivatives or analogs of endostatin.

The rejection is traversed for the following reasons.

The instant specification teaches by way of reference a number of active fragments, analogs and variants of endostatin, for example, U.S. Patent Nos. 6,174,861 and 5,854,205, and published PCT applications, WO 00/67771, WO 00/63249, WO 99/31616, WO 99/29855 and WO 99/48924.

Moreover, the instant specification teaches a bioassay to determine whether any one fragment, derivative or analog has the requisite biological activity of interest.

At the top of page 5 of the Office Action, the Examiner indicated that should the claims recite functionally active variants, analogs or derivatives of endostatin, the written description requirement would be met.

Applicants have accepted that suggestion and the various transgenes of interest are those that express a functionally active molecule.

Hence, the rejection can be removed.

VI. In item 12 on page 5 of the Office Action, claims 1, 3, 5-8, 17-22 and 28-41 were rejected under 35 U.S.C. §112, first paragraph, for an alleged want of an enablement. The reason for the rejection parallels that for the alleged insufficient written description discussed herein above.

The rejection is traversed for the following reasons.

To the contrary, Applicants maintain that the instant specification teaches how to make and how to use any analog, variant or derivative of endostatin.

In any event, in view of the amendment of the claims to recite that the various transgenes are functionally active, clearly that is taught and supported by the instant specification. Hence, the claimed invention is enabled and withdrawal of the rejection is in order.

VII. Beginning at the bottom of page 13 of the Office Action, claims 1-3, 5-8, 17-22 and 27-41 were rejected under 35 U.S.C. §112, first paragraph, for an alleged want of an enablement.

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The rejection is traversed for the following reasons.

At the top on page 6 of the Office Action, the Examiner offered an independent claim that is fully enabled by the instant specification and Applicants have accepted that claim, which is provided in amended claim 1.

Hence, the pending claims clearly are enabled by the instant specification which provides a thorough description of how to make and how to use the claimed invention. In view thereof, withdrawal of the rejection is in order.

VIII. In items 15 and 16 on pages 10 and 11 of the Office Action, claims 1-3, 5-9, 27, 28, 30 and 31 were rejected under 35 U.S.C. §102(b) over WO 99/26480.

The rejection is traversed for the following reasons.

WO 99/26480 does not provide an enabling disclosure for the direct administration of a viral vector to the eye to treat ocular neovascularization.

WO 99/26480 is not an enabling reference as to the claimed invention and does not place the claimed invention in the hands of the public. Hence, there is no anticipation. Accordingly, the rejection is improper and must be removed.

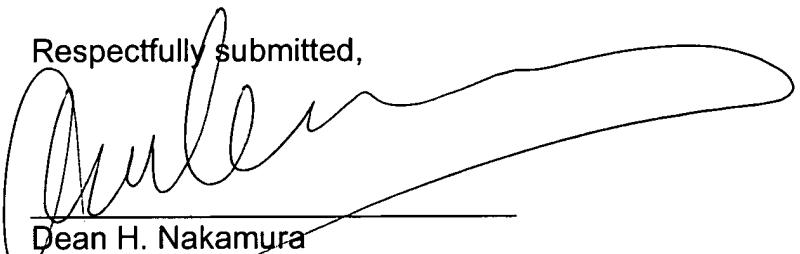
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CONCLUSION

Applicants submit that the pending claims are in condition for allowance and early indication of such is respectfully requested. Re-examination, reconsideration, withdrawal of the objection and rejections and early passage to issuance are solicited earnestly. If any fees are found to be applicable, please charge any additional fees or make any credits to Deposit Account No. 07-1896.

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Respectfully submitted,


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